

**REMARKS**

The Office Action dated October 4, 2004 has been carefully reviewed and the foregoing amendments are made in response thereto. In view of the amendments and the following remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Claims 7 and 17 have been amended. Claim 7 has been amended in accordance with the Examiner's suggestions. Claim 17 has been amended to incorporate the specific salt concentration and temperature of the stringent hybridization conditions. Support for this amendment can be found on page 7, lines 15-16 of the specification. No prohibited new matter has been introduced by these amendments.

**Objections to the Specification and Drawings**

The specification and drawings are objected to because the Examiner cannot find Table 1 in the specification and Figure 1 does not contain SEQ ID NOS as indicated in the specification. Applicants respectfully submit that the Examiner may have confused the original Figures with the later amended Figures and Tables. Four Figures were originally filed with the present application, among which Figures 1 and 2 have been canceled. The content of Figures 1 and 2 has been converted to Tables 1 and 2 which have been appended to the end of the original specification. The Examiner's attention is directed to Applicants' Amendment dated August 1, 2001, where on page 1 it is instructed that after page 20 of the specification, "please enter Table 1 as pages 21-68 and Table 2 as pages 69-74." The Amendment further explains on page 5 under the heading "Objections to the Drawings and Specification" that Figures 3 and 4 have been renumbered as Figures 1 and 2. As a result, the amended Figure 1, which is currently pending, depicts a computer system and Figure 2 refers to a system block diagram. None of the outstanding figures refers to SEQ ID NOS as alleged by the Examiner.

Applicants note that the amendments to the Figures and Tables have subsequently been approved by Examiner Siew in the Office Action dated October 28, 2002. Since the amendments to the Figures and Tables have been entered, Applicants respectfully request the withdrawal of this objection.

**Claim Objections**

Claims 5, 7, 9, and 10 have been objected to for alleged informalities in the claims. In particular, claim 5 is objected to because the Office Action alleges that the scope of claim 5 is broader than claim 4 from which claim 5 depends. Applicants respectfully traverse. Claim 4 recites “the sequence of a segment of at least 50 contiguous bases from the target nucleic acid.” Claim 5 recites “the method of claim 4, wherein at least 100 contiguous bases are determined from the target nucleic acid.” The term “at least 50 contiguous bases” is open-ended. It may read on any contiguous bases equal to or greater than 50 bases, which includes “at least 100 contiguous bases.” On the other hand, the term “at least 100 contiguous bases” has a range of equal to or greater than 100 bases, which does not include sequences fewer than 100 contiguous bases. Thus, the term “at least 50 contiguous bases” encompasses the term “at least 100 contiguous bases,” not vice versa. Therefore, contrary to the Examiner’s assertion, claim 5, being narrower than claim 4, further limits claim 4 from which it depends.

Claim 7 has been objected to as allegedly being in an improper form. The Examiner suggests that “SEQ ID NOS.” be changed to “SEQ ID NOS:” Applicants have amended the claim as suggested by the Examiner, rendering the objection moot.

Claims 9 and 10 are objected to because the Office Action alleges that the scope of claims 9 and 10 are broader than claim 8 from which claims 9 and 10 depend. Claim 8 recites the identify of “at least 10 bases” whereas claims 9 and 10 recite “at least 20 bases,” which have a narrower scope than claim 8. For the same reasons given in the above discussion of the claim 5 objection, withdrawal of objection to claims 9 and 10 is requested.

In view of the foregoing remarks, Applicants respectfully request that the objections to claims 5, 7, 9, 10 be withdrawn.

**Rejections under 35 U.S.C. § 112 (second paragraph)**

Claim 17 has been rejected allegedly as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. In particular, the Examiner takes the position that the definition of “stringent hybridization conditions” is ambiguous. Solely in an effort to advance prosecution of the instant application and not in acquiescence of the rejection, claim 17 has been amended to specify that the stringent hybridization conditions comprise 5 x SSPE and a temperature of 25-30° C. Support of the amendment can be found on page 7, lines 15-16 of the specification. Applicants respectfully submit that the amendment to the claim and the disclosure of the

specific stringent hybridization conditions in the specification render the rejection moot.  
Withdrawal of the rejection is respectfully requested.

***Conclusion***


In view of the foregoing remarks, Applicants respectfully request withdrawal of all outstanding rejections and early notice of allowance to that effect. If the Examiner has any further questions or concerns regarding the amendments made herein or previously, or the application in general, she is encouraged to telephone the undersigned at her convenience.

Except for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No.50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

**MORGAN, LEWIS & BOCKIUS LLP**

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